

REMARKS

I. Status of the Claims

The Office Action of January 29, 2010 (the "Office Action")¹ rejected claims 22-25, 39, and 43 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter, rejected claim 43 under 35 U.S.C. § 112, ¶ 2 as allegedly being indefinite, and rejected claims 1-4, 10-15, 21-25, 37-39, and 41-43 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Pat. Pub. No. 2008/0082620 to Barsness et al. ("*Barsness*") in view of U.S. Patent No. 7,043,530 to Isaacs et al. ("*Isaacs*"). The Office Action also allowed claim 44, and indicated that claims 5-9 and 16-20 would be allowable if rewritten in independent form including all of the limitations of their base claim and any intervening claims.

By this Amendment, Applicants have amended claims 1, 14-16, 21-25, 37-39, and 43, and cancelled previously withdrawn claims 27-36, without prejudice or disclaimer of the subject matter thereof. Claims 26 and 40 were previously cancelled. Claims 1-25, 37-39, and 41-44 are currently pending. No prohibited new matter has been added.

Applicants respectfully submit that amended claims 1-25, 37-39, and 41-44 are in condition for allowance, and request that these claims be timely allowed for at least the following reasons.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. Examiner Interview of May 27, 2010

Applicants thank the Examiner for the courtesies extended during the telephonic interview conducted on May 27, 2010. During the course of the interview, the rejections under 35 U.S.C. § 103(a) were discussed and Applicants' representative presented arguments concerning the differences between the *Barsness* and *Isaacs* references and Applicants' claims. In addition, the 35 U.S.C. §§ 101 and 112, ¶ 2 rejections were discussed by the Examiner and Applicants' representative.

During the interview of May 27, 2010, the Examiner suggested specific amendments to claims 1, 21, 22, and 43 that would overcome the rejections under 35 U.S.C. §§ 103(a), 101, and 112, ¶ 2. and place the application in condition for allowance. Applicants again thank the Examiner for his helpful suggestions. The present amendments have been made consistent with the Examiner's suggestions, and therefore, allowance of the present application is respectfully requested.

III. Rejection of Claims 22-25, 39, and 43 under 35 U.S.C. § 101

The Office Action rejected claims 22-25, 39, and 43 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This is incorrect. The pending claims are clearly directed to statutory subject matter.

While Applicants disagree with these rejections, in an effort to advance prosecution, Applicants have amended independent claim 22 to recite "A non-transitory computer readable medium storing a program comprising instructions for" In addition, Applicants have amended dependent claims 23-25, 39, and 43 to recite "The non-transitory computer readable medium of claim 22" These amendments are

consistent with the Examiner's suggestions provided during the interview of May 27, 2010.

Accordingly, amended claims 22-25, 39, and 43 are drawn to statutory subject matter, and the rejections under 35 U.S.C. § 101 should be withdrawn.

IV. Rejection of Claim 43 under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected claim 43 under 35 U.S.C. § 112, ¶ 2 as allegedly being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

By this Amendment, Applicants have amended claim 43 for purposes of providing greater clarity. This amendment is also consistent with the suggestions by the Examiner during the interview of May 27, 2010. Accordingly, amended claim 43 is definite and the rejection under 35 U.S.C. § 112, ¶ 2 should be withdrawn.

V. Rejections under 35 U.S.C. § 103(a)

The Office Action rejected claims 1-4, 10-15, 21-25, 37-39, and 41-43 under 35 U.S.C. § 103(a) as allegedly being obvious over *Barsness* in view of *Isaacs*. Specifically, the Office Action rejected claims 1, 10, 21,² 22, and 37-39 over *Barsness* and *Isaacs*, rejected claims 2-4, 13-15, 23-25, and 41-43 over *Barsness*, and claims 11-12 over *Isaacs*. Applicants respectfully disagree with the basis for these rejections and submit that the pending claims are allowable over the prior art of record.

² Applicants note that the Office Action mistakenly referenced claim 20, rather than claim 21, on page 6.

Nonetheless, in order to advance prosecution of this application, Applicants have amended independent claims 1, 21, and 22 to recite, *inter alia*, “enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host based on voice communication capabilities of the recipient” (emphasis added). During the telephonic interview on May 27, 2010, the Examiner indicated that such amendments to independent claims 1, 21, and 22, would place these claims, and their dependent claims 2-4, 10-15, 23-25, 37-39, and 41-43, in condition for allowance. For the reasons stated during the Examiner interview, Applicants point out that the amended feature is not the only basis for the patentability of Applicants’ claims over the prior art record.

Accordingly, Applicants request that the rejections under 35 U.S.C. § 103(a) of claims 1, 21, and 22, and their dependent claims, be withdrawn and the claims timely allowed.

CONCLUSIONS

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of claims 1-25, 37-39, and 41-44.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 1, 2010

By: Elliot C. Cook
Elliot C. Cook
Reg. No. 61,769
(571) 203-2700